

ESTTA Tracking number: **ESTTA873302**

Filing date: **01/25/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Khaled M Khaled
Granted to Date of previous extension	01/27/2018
Address	c/o Sedlmayr & Associates, P.C. 489 Fifth Avenue, 30th Floor New York, NY 10017 UNITED STATES

Attorney information	Barbara A. Friedman Edell Shapiro & Finnan LLC 9801 Washingtonian Blvd. Suite 750 Gaithersburg, MD 20878 UNITED STATES Email: efile@usiplaw.com Phone: 301-424-3640
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Applicant Information

Application No	87541379	Publication date	11/28/2017
Opposition Filing Date	01/25/2018	Opposition Period Ends	01/27/2018
Applicant	Business Moves Consulting Inc 17927 Windflower Way DALLAS, TX 75252 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Magazine publishing
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4198000	Application Date	01/16/2012
Registration Date	08/28/2012	Foreign Priority Date	NONE
Word Mark	WE THE BEST		

Design Mark	WE THE BEST
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/06/12 First Use In Commerce: 2007/11/00 Musical sound recordings; Downloadable musical sound recordings Class 041. First use: First Use: 2007/00/00 First Use In Commerce: 2007/00/00 Entertainment services in the nature of recording, production, and post production services in the field of music; Production of musical sound recordings; Music production services; Entertainment services in the nature of presenting live musical performances

U.S. Registration No.	5031701	Application Date	01/25/2016
Registration Date	08/30/2016	Foreign Priority Date	NONE

Word Mark	WE THE BEST
Design Mark	WE THE BEST
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/00/00 First Use In Commerce: 2007/00/00 Musical sound recordings; musical videorecordings; headphones; protective covers and cases for cell phones Class 025. First use: First Use: 2006/00/00 First Use In Commerce: 2006/00/00 Clothing, namely, shirts, jackets, tops, caps and hats; footwear; headwear Class 041. First use: First Use: 2006/00/00 First Use In Commerce: 2006/00/00 Disc jockey services; Music video production; Entertainment services in the nature of recording, production, and post production services in the field of music; Production of musical sound recordings; Music production services; Entertainment services in the nature of presenting live musical performances; Entertainment services in the nature of live disc jockey and rap artist personality performances; Entertainment services, namely, live appearances by a professional entertainer; Arranging, organizing, conducting, and hosting social entertainment events; Master of ceremonies for parties, live musical entertainment performances, and special entertainment and social events; Arranging, organizing and

	conducting and hosting night club parties; Hosting special entertainment and social events for others
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U.S. Registration No.	5032062	Application Date	04/18/2016
Registration Date	08/30/2016	Foreign Priority Date	NONE
Word Mark	WE THE BEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2015/12/09 First Use In Commerce: 2015/12/09 online retail store services featuring clothing and apparel, footwear, fashion accessories, headphones, entertainment electronics</p> <p>Class 041. First use: First Use: 2016/02/05 First Use In Commerce: 2016/02/05 Entertainment services in the nature of an ongoing music and talk radio program featuring music, comedy, current events, inspirational and motivational programming, and celebrity interviews</p>		

U.S. Registration No.	5341520	Application Date	03/19/2016
Registration Date	11/21/2017	Foreign Priority Date	NONE
Word Mark	WE THE BEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 034. First use: First Use: 2016/03/14 First Use In Commerce: 2017/04/01 Electronic cigarette liquid (e-liquid) comprised of vegetable glycerin</p>		

Attachments	85517034#TMSN.png(bytes)
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Signature	/Barbara A. Friedman/
Name	Barbara A. Friedman
Date	01/25/2018

THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

Khaled M. Khaled,

Opposer,

Opposition No. _____

v.

Mark: We The Best Lifestyle

Ser. No.: 87541379

Business Moves Consulting Inc.

Applicant.

NOTICE OF OPPOSITION

Khaled M. Khaled (“Opposer”), whose performance name is DJ Khaled, and whose business address is c/o Sedlmayr & Associates, P.C, 489 Fifth Avenue, 30th Floor, New York, New York 10017, believes that he will be damaged by the issuance of a registration for the mark We The Best Lifestyle under Application Serial No. 87541379. Application Serial No. 87541379 was published for opposition on November 28, 2017. Having been granted an extension of time to oppose up to and including January 27, 2018, Opposer hereby opposes registration of the same, pursuant to Section 13(a) of the Lanham Trademark Act of 1946. As grounds for its opposition, Opposer alleges as

follows, with knowledge concerning his own acts, and on information and belief as to all other matters:

1. Opposer is a well-known as an entertainer, record producer, radio personality, record label executive, and media celebrity. Opposer also is well known by a number of his identifying phrases, including, among others, WE THE BEST.

2. The phrase “We the Best” is an intentional corruption of the phrase “we are the best” in which the verb component of the phrase has been omitted.

3. *We The Best* is the name of Opposer’s second studio record album, released in 2007, and is the title to the first track on the album.

4. Following the release of his *We The Best* album, Opposer began repeating the phrase “we the best” in musical recordings, interweaving the spoken words amidst other lyrics and music. He also began repeating the phrase “We the Best,” shouting it from the stage at his live performances. As a result of this frequent use of the phrase “We the Best,” Opposer’s fans and attendees at said performances grew to associate “We the Best” with Opposer. In a short period of time, Opposer’s fans and attendees at his live performances came to expect Opposer to use and shout out the phrase “We the Best” as his signature phrase.

5. In or around 2010, Opposer founded the WE THE BEST MUSIC GROUP as a record label, first as an imprint of The Island Def Jam Music Group, then as an imprint of Universal Records’ Cash Money Records division. In or around April 2016, the WE THE BEST MUSIC label moved to Epic Records, the major record label owned by Sony Music Entertainment.

6. WE THE BEST MUSIC is not only a record label, but also the name of Opposer's management company, music publishing company, music production company, and the name of Opposer's flagship recording studio.

7. In 2011, Opposer released his fifth studio album under the title WE THE BEST FOREVER.

8. In 2014, under the name WE THE BEST SOUND, Opposer partnered with HEADS Audio and Bang & Olufsen Play to produce a signature audio headphone under the WE THE BEST mark.

9. In or around 2015, Opposer's social media presence began to gain enormous attention, including on the Snapchat and Instagram sites, where Opposer posted videos and photos of his everyday life scenes and events. Such social media posts, which also include inspirational messages and uplifting comments, gained some two million followers in a short period of time. Followers of Opposer's Instagram posts now number over nine million. On Snapchat, Opposer gets 3 to 4 million views on each of his Snaps. He has almost four million followers on Twitter. His Instagram account posts number over twenty-four million. His Instagram video posts "views" are in the hundreds of thousands. His Instagram photograph posts typically have multiple tens of thousands of "likes."

10. Most of Opposer's aforementioned social media posts include the tag "wethebestmusic" or #wethebest, by which Opposer's followers identify the posts as originating with Opposer. WE THE BEST and Opposer are thus one and the same in the minds of Opposer's followers, fans, and the consuming public.

11. In December 2015, Opposer launched his online retail webstore WETHEBESTSTORE.COM, to sell his expanding line of merchandise. The launch of this site was reported in the *Inquisitr* online publication on December 13, 2015, which characterized Opposer's WE THE BEST name as "his ubiquitous phrase."

12. In January 2016, Opposer partnered with a Miami-based radio station, Hot 97, which conducted a WE THE BEST COUPLE contest, in which couples described their 'keys to a successful relationship' and the winning couple, announced after Valentine's day, won a trip to Miami to meet Opposer.

13. In February 2016, Opposer signed with Apple Music, and launched his *We The Best Radio* program on the Beats 1 internet music radio station.

14. In December 2016, Opposer partnered with E.T. Browne Drug Co. Inc., and launched his WE THE BEST GLOW body lotion in the well-known Palmer's Cocoa Butter Formula skin care line.

15. In 2016, Opposer partnered with an electronic cigarette liquid producer and launched a line of liquids for electronic cigarettes under the WE THE BEST mark.

16. Opposer and his WE THE BEST mark have been the subject of and featured in numerous articles published in mass media publications, both online and hard copy, including, but not limited to, *Forbes* (November 7, 2014 article titled "How Many Times Can DJ Khaled Say 'We The Best' in 40 Seconds?"), *The New York Times*, *GQ Magazine*, *Billboard*, and *Time Magazine*.

17. Opposer has appeared on such network television programs as *The Ellen Show*, *Jimmy Kimmel Live*, *Live With Kelly And Ryan*, *The Chew*, *Rachael Ray*, *The Daily Show*, *Late Night With Stephen Colbert*, *Late Night With Seth Meyers*, and *Good*

Morning America, in which appearances his WE THE BEST mark has been prominently featured and publicized.

18. As a result of the acclaim garnered by his performance, recording and other entertain-related services, his enormous social media presence, and the popularity and widespread acceptance of his inspirational sayings, among other things, Opposer has become extremely well-known and popular. As a result, his phrase WE THE BEST, which appears and is used widely in all of the aforementioned media, has become well-known across diverse consumer populations.

19. Opposer owns U.S. Trademark Registration Numbers 4198000, 5031701, 5032062, and 5341520, all for the WE THE BEST trademark. Registration 4198000, which is now incontestable, covers musical recordings, live musical performance, music production, record production; Registration 5031701 covers headphones, recordings, clothing, disc jockey services; music video production; various entertainment services; music production services; Registration 5032062 covers his online retail clothing store services and his internet radio program; Registration 5341520 covers e-cigarette liquid (hereinafter, “Opposer’s products and services”).

20. “WE THE BEST” is a phrase and mark that is associated with Opposer, Opposer’s products and services, his social media postings, and his persona, identifying him as the source of the aforementioned products and services.

21. As a result of Opposer’s reputation, use, enormous success and significant promotional efforts, Opposer’s WE THE BEST mark has developed a strong, distinctive meaning and significance in the minds of the public, and has become a strong trademark identifying Opposer’s products and services exclusively. As such, the WE THE BEST

mark represents enormous goodwill and is an extremely valuable asset belonging to Opposer.

22. As a result of Opposer's reputation, use, substantial success, inestimable popularity, and significant promotional efforts, Opposer's WE THE BEST mark became famous prior to any date upon which Applicant can rely to establish priority in the phrase We The Best Lifestyle.

23. Application Serial No. 87541379 was filed on July 25, 2017 by Applicant, based on an intention to use the mark We The Best Lifestyle for magazine publishing services.

24. On information and belief, the Applicant offers business services and is not a magazine publisher.

25. On information and belief, Applicant has no magazine publishing service.

26. Upon information and belief, Applicant has made no use of We The Best Lifestyle in commerce.

27. On information and belief, July 25, 2017 is the earliest date on which Applicant could have relied to establish priority in this case.

28. On information and belief, prior to filing its Application Serial No. 87541379, Applicant was fully aware of Opposer's WE THE BEST mark and of Opposer's prior use of the mark in commerce.

29. On information and belief, Applicant did not file Application Serial No. 87541379 until after it was aware of Opposer's use of the WE THE BEST mark in commerce, and of the fame of the mark and the significant good will associated therewith.

30. On information and belief, the Applicant's proposed use and attempted registration of We The Best Lifestyle is in bad faith and is an intentional effort to derive benefit from the well-established goodwill developed by Opposer in the WE THE BEST mark.

31. Applicant's services in Application Serial No. 87541379 are sufficiently related to Opposer's goods and services and, upon information and belief, will be offered to classes of customers similar to those to whom Opposer's goods and services are offered and sold.

32. The mark in Application Serial No. 87541379 is so similar to Opposer's WE THE BEST mark, that, when applied to Applicant's services, consumers will likely be confused, mistaken or deceived as to the source of the services, from which damage to Opposer is inevitable.

33. In that Opposer's rights in the WE THE BEST mark are long prior to any date on which Applicant can rely in establishing priority, registration of We The Best Lifestyle should be barred under Section 2(d) of the Lanham Act.

34. Opposer's WE THE BEST mark is famous and had become famous long before the earliest priority date upon which Applicant can rely. Because Opposer's WE THE BEST mark is famous, registration of Applicant's mark in Application Serial No. 87541379 will damage Opposer by trading on the enormous goodwill associated with the Opposer's WE THE BEST mark and diluting its distinctiveness. Thus, Applicant's use and registration of the mark in Application Serial No. 87541379 for the services identified therein will likely cause dilution by blurring of Opposer's famous WE THE BEST mark in violation of Sections 13(a) and 43(c) of the Lanham Act.

35. By reason of the foregoing, Opposer is likely to be harmed by the registration of Applicant's mark in Application Serial No. 87541379.

WHEREFORE, Opposer requests that this opposition be sustained, that registration of Application No. 87541379 be refused, and for such other relief as the Board may deem equitable and appropriate.

Date: January 25, 2018

Respectfully submitted,



Barbara A. Friedman/
Edell Shapiro & Finnan LLC
9801 Washingtonian Blvd. Suite 750
Gaithersburg, Maryland 20878
Attorneys for Opposer
301-424-3640
efile@usiplaw.com; baf@usiplaw.com